REMARKS

Claims 1-5 are pending in this application, with Claim 1 being independent. Claim 1 has been amended to clarify that the web having an applied pattern of add-on material is that of a cigarette wrapper. No new matter has been added.

Reconsideration of the outstanding rejections in view of the following remarks is respectfully requested.

CLAIM REJECTION UNDER 35 U.S.C. §103(a)

In the Examiner's Answer, Claims 1-5 have been newly rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,997,691 ("Gautam") as further evidenced by U.S. Patent No. 6,214,166 ("Münchow"), U.S. Patent No. 3,596,840 ("Blomqvist"), or U.S. Patent Application Publication No. 2005/0167534 ("Tomikawa"). This rejection is respectfully traversed.

The Examiner's Answer cites Gautam as teaching:

> a method of making a web in which a base web is moved along a first path, a slurry of cellulosic material is prepared as an[] add-on to the base web; and repetitive[ly] discharging the add-on-material. . . . [T]he add-on material is discharged using a moving belt having an orifice along the endless path. . . . [F]lax straw [is used] as the add-on material. . . . [T]he add-on material is cooked, bleached and then grinded, i.e., refined." (Page 4).

Admitting that Gautam fails to teach the recited feature of milling the dried material (which the Office Action appears to equate with "dry grinding"), the Examiner's Answer further asserts,

> The only difference between the claimed invention and Gautam et al. invention is [] the way in which the add-on material is ground, i.e., Gautam et al. teach a wet grinding process, while the present application teaches the dry comminution of the add-on materials. However, using either process of grinding is within the level[] of ordinary skill in the art, since both of them are very well known in the art. Note that if one desires to do the dry grinding operation, then the steps of pressing and drying the slurry are [] necessary and also very well known in the dry market pulp. Wet and dry grinding are functional equivalent processes. . . . (Page 4).

The Examiner's Answer cites Blomqvist, Münchow, and Tomikawa as evidence of the "'functional[] equivalence' of the dry and wet [grinding] process[es] for comminuting additives." (Page 5). Applicants respectfully submit that none of Blomqvist, Münchow, or Tomikawa provide evidence of the alleged equivalence between wet and dry grinding, either in a papermaking process or in a method for

preparing a slurry of add-on material to be applied in a predetermined pattern on a base web. Furthermore, contemporaneous materials confirm that dry grinding is not equivalent to wet grinding in papermaking processes.

Moreover, none of Blomqvist, Münchow, or Tomikawa is reasonably pertinent to the particular problem with which the Applicants were concerned or in the field of Applicants' endeavor, namely, a method and apparatus for preparing a slurry of add-on material to be applied in a predetermined pattern on a base web, preferably in the form of bands, and more particularly, to a method and apparatus for producing cigarette paper having banded regions of the additional material. (Page 1, Paragraph [0001]). Accordingly, the Blomqvist, Münchow, and Tomikawa references do not properly support the rejection of Claims 1-5.

Applicants respectfully disagree with the rejection of Claims 1-5 as unpatentable over Gautam as further evidenced by Münchow, Blomqvist, or Tomikawa. Therefore, withdrawal of this rejection is respectfully requested.

A. Response to Arguments

1. Obvious to Try

The Examiner's Answer asserts that "in recent court decisions, KSR; it has been held that it obvious to try, choosing from a finite number of identified, predictable solutions." (Page 7; *Ssee also* page 8). As explained in the recently published U.S. Patent and Trademark Office examination guidelines, to reject a claim based on the rationale of "Obvious to Try",

> Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:
>
> (1) a finding that at the time of the invention, there had been a ***recognized problem or need in the art***, which may include a design need or market pressure to solve a problem;
>
> (2) a finding that there had been a finite number of identified, ***predictable*** potential solutions to the recognized need or problem;
>
> (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a ***reasonable expectation of success***; and
>
> (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.
>
> The rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill has ***good reason to pursue the known options*** within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the

> fact that a combination was obvious to try might show that it was obvious under § 103."[footnote omitted] If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. (Emphasis Added; 72 FR 57526, 57532).

Applicants respectfully submit, *inter alia*, that: (1) no recognized problem or need in the art existed, (2) "dry grinding" would not provide a predictable potential solution, for reasons outlined below, and (3) one of ordinary skill in the art could not have pursued the known potential solutions with a reasonable expectation of success -- again, for reasons outlined below.

2. Preparing the Slurry of Add-on Material

The Examiner's Answer asserts that "the fibers of the present invention are not be[ing] used to make the base paper, but as an additive, i.e. an[] add-on and therefore, [] one of ordinary skill in the art would not need to be concerned with the same variables. . . ." (Page 7). Applicants respectfully disagree.

The step of preparing the slurry of add-on material (which is repetitively discharged upon the moving base web) includes cooking a fibrous cellulosic material, bleaching the material, pressing the cooked and bleached material to remove liquid, drying the pressed material, milling the dried material to produce fibers of a desired size, and mixing the milled material with water to hydrate the material and produce a slurry, Applicants respectfully submit that one of ordinary skill in the art ***would*** need to be concerned with variables outlined below.

Further, the Examiner's Answer repeats a portion of the quotation from U.S. Patent No. 5,385,640 cited on page 9 of Applicant's Appeal Brief (see page 8 of the Examiner's Answer), Applicants respectfully submit that the point of this citation has been misunderstood. In particular, as noted below, while the prior art specifically discloses the use of wet grinding in papermaking, the prior art also specifically explains why dry grinding is not a suitable substitute for wet grinding in papermaking. Accordingly, the prior art teaches away from substituting dry grinding for wet grinding in papermaking. Thus, one of ordinary skill in the art would not equate wet grinding and dry grinding in the papermaking art.

B. Claims 1-5

Wet grinding and dry grinding are not equivalent processes.

Claim 1 recites a method of manufacturing a web having an applied pattern of add-on material including, *inter alia*: preparing a slurry of add-on material by cooking a fibrous cellulosic material, bleaching the material, pressing the cooked and bleached material to remove liquid, drying the pressed material, milling the dried material to produce fibers of a desired size, and mixing the milled material with water to hydrate the material and produce a slurry.

Applicants respectfully submit that ***a prima facie case of obviousness has not been established***. Moreover, Applicants further respectfully submit that the improved results and more economical process associated with "dry grinding" in the claimed method, as compared to "wet grinding", also rebut any possible *prima facie* case of obviousness.

More particularly, the ***cited references teach away from the presently claimed method***. Because there is no factual basis for asserting that dry milling is the equivalent of wet grinding, the process recited in Claims 1-5 would not be obvious to one of ordinary skill in the art on this record.

Thus, Applicants respectfully submit that the rejection of Claim 1 should be withdrawn and Claim 1 should be allowed. Claims 2 and 3 depend from Claim 1 and should also be allowed therewith.

C. Claim 4

Claim 4 pertains to a method according to claim 3 that further includes subjecting the flax straw feed stock to a process for removing non-fibrous components including shive before the step of cooking the fibrous cellulosic material. The Examiner's Answer asserts, "With regard to claims 4 and 5, the steps of removing shives and contaminants from a pulp is very well known and necessary step(s) after the cooking of the pulp." (Pages 4-5).

Applicants respectfully submit that the Examiner's Answer does not provide any factual basis for the assertion that "the steps of removing shives and contaminants from a pulp is very well known and necessary step(s) after the cooking of the pulp". As Applicants have challenged a factual assertion of the Examiner's Answer as not properly officially noticed or not properly based upon common

knowledge, Applicants request that documentary evidence be provided in the next Office Action if the rejection is to be maintained.

Notwithstanding the foregoing, Claim 4 depends ultimately from Claim 1 and should be allowable therewith. But in addition, Applicants submit that the further basis for rejecting Claim 4 is untenable. For example, Chapter 9, Pages 98-132, of the *Handbook for pulp and paper technologists*, 2nd edition, deals with processing of pulps following the step of cooking. Figure 9-1, which is a schematic flowsheet for a kraft dissolving pulp mill, shows the following stations: a "Woodyard and Chipping" station followed by a "Cooking" station, then "Washing", "Screening I", "Bleaching", "Screening II", "Drying Machine", and finally "Finishing Department" stations. Furthermore, section 9.1, entitled "Defibering", begins, "All high-yield chemical and semichemical pulps must be defiberized by mechanical means following the cooking step." Similarly, the first paragraph of section 9.2, "Deknotting", ends with the sentence, "Knots are removed from the pulp prior to washing, and are either discarded as waste or returned to the digester infeed." Section 9.3 begins discussion of washing, specifically "Brown Stock Washing".

Applicants respectfully submit that Gautam does not disclose subjecting flax straw feed stock to a process for removing non-fibrous component including shive before the step of cooking the fibrous cellulosic material, as recited in Claim 4.

Accordingly, withdrawal of the rejection with respect to Claim 4 is respectfully requested.

D. <u>Claim 5</u>

Claim 5 also ultimately depends from Claim 1 and is allowable therewith. Claim 5 recites the method according to Claim 4, wherein the process for removing the non-fibrous component is preformed in a hammer mill.

Applicants respectfully submit that neither Gautam nor the *Handbook for pulp and paper technologists*, 2nd edition, discloses performing the process for removing the non-fibrous component in a hammer mill, as recited in Claim 5.

Accordingly, withdrawal of the rejection with respect to Claim 5 is respectfully requested.

E. Supplemental Information

In further support of the positions described above, Applicants will submit a declaration pursuant to 37 C.F.R. § 1.132 along with a supplemental response to this new rejection.

CONCLUSION

Based on the foregoing discussion, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN, INGERSOLL & ROONEY P.C.

Date: January 25, 2008

By: Regis E. Slutter
Regis E. Slutter
Registration No. 26,999

P.O. Box 1404
Alexandria, Virginia 22313-1404
703-836-6630